REMARKS

The final Office Action objects to claim 61, and again rejects claims 54, 56, 58-61 under 35 USC §103(a) over Chumley in view of Young and further in view of Hahn.

The present Amendment requests reconsideration in view of the following remarks.

Objection

In response to the objection to claim 61, applicant agrees that the phrase or limitation "the movable vehicle locator swivel plate pivots in a vertical plane" can be construed quite broadly. Applicant respectfully asserts, however, that when said phrase or limitation is read within the context of the entire step recitation, the scope of the phrase or limitation is definitely limited, not overly broad. The entire step reads:

placing two wheels of a second vehicle on a movable vehicle locator swivel plate located on a top side of said base behind said wheels adjacent a rear end of said base where **said movable vehicle locator swivel plate pivots in a vertical plane** on a pivot bolt attached to the bottom of said movable vehicle locator swivel plate.

Applicant respectfully asserts that when read in its entirety, the vertical plane at which the movable vehicle locator swivel plate pivots is understood to be limited to pivoting only in a vertical plane relative the pivot bolt attached at the bottom. That is, the movable vehicle locator swivel plate can only pivot about the bolt in one vertical plane, which is always fixed. Applicant, therefore, respectfully asserts that "the movable

vehicle locator swivel plate pivots in a vertical plane" is not overly broad, and requests withdrawal of the objection.

35 USC §103(a)

To support the final rejection, the Examiner asserts that Chumley discloses a movable vehicle locator swivel plate (E, 59, 60) mounted on an upper side of and adjacent to the rear end of a base **to the rear of said axis of rotation** for supporting two wheels of a second vehicle being towed, the movable vehicle locator swivel plate pivoting around a vertical axis (61) as a point of rotation for said vehicle being towed as the towing vehicle moves through a radius of a turn, that Chumley does not teach that the movable vehicle locator swivel plate is located **to the rear of the axis of rotation**, nor means for adjusting the MLSP..., as claimed.

The Examiner further states that Young teaches a movable vehicle locator swivel plate (70) located to the rear of the axis of rotation, and means for adjusting the movable vehicle locator swivel plate ...., that Hahn teaches that it is known for having longitudinal adjusting means comprising a pair of longitudinally spaced openings with a downwardly extending a pivot bolt (60) for holding vehicle wheels in a desired location and that it would have been obvious "to have tried" modifying Chumley by Young and Hahn to realize a movable vehicle locator swivel plate longitudinally adjustable and located to the rear of said axis of rotation in order to achieve the predictable result of **better towing (and inherently balancing) of a second vehicle** and have **more room on the forward**

vehicle tow rack, and to have longitudinal adjusting means comprise a plurality of longitudinal spaced openings with a downwardly extending pivot bolt for achieving the predictable result of **holding vehicle wheels at a desired location**."

Applicant respectfully disagrees that it would have been "obvious to try" to modify Chumley by the teachings of Young and Hahn, or that such a proposed combination would realize a movable vehicle locator swivel plate mounted on an upper side of and adjacent to the rear end of a base to the rear of an axis of rotation (of the pair of wheels), a downwardly extending pivot bolt for pivoting around a vertical axis and longitudinal adjusting means comprising a plurality of longitudinal spaced openings for receiving the pivot bolt, or otherwise be obvious in view of Chumley, Young and Hahn for at least the following reasons.

First, applicant respectfully disagrees with the Examiner's characterization of Chumley, that Chumley's towing connection (swivel plate) E is mounted on an upper side of and adjacent the rear end of Chumley's base (B), as asserted. Chumley's Figs. 11 and 12 show that towing connection E includes a slightly lowered extension of the frame or base B (illustrated at 58), together with inclined ramp 59. That is, Chumley's swivel plate E is not mounted "on an upper side of and adjacent the rear end of the base," as claimed (but on 58), and is directly at the axis of rotation of the wheels, D.

Chumley's central vertical pivot 61 is fixed at the axis of rotation of wheels, D, and does not appear to be adjustable. Nowhere in Chumley's text is suggested that the central vertical pivot location can be moved, or any reason or benefit for doing so, e.g.,

moving the location of central vertical pivot 61 off of the axis of rotation of wheels, D, particularly in view of the fact that Chumley's swivel plate E must also pivot about the axis of rotation of wheels, D, as is clear by Fig. 12.

Applicant further respectfully disagrees that Young teaches a moveable vehicle locator swivel plate (70) located **to the rear of said axis of rotation** (for supporting two wheels of a vehicle being towed) that is longitudinally adjustable in order to better tow a second vehicle. Young's wheel supporting cradle (movable vehicle locator swivel plate; 70) is shown in Fig. 4 is part of a wheel lift apparatus, and is not located on an upper side of and adjacent the rear end of the base (30) to the rear of said axis of rotation of wheels connected to the base, as claimed.

While Young can adjust a location of cradle (70), Young could not be combined or modified to operate with swivel plate E of Chumley. The structure is too dissimilar. Moreover, Young's cradle (70) does not "pivot about a vertical axis" as claimed.

Applicant further respectfully disagrees that Hahn teaches longitudinal adjusting means comprising a plurality of longitudinal spaced opening with a downwardly extending a pivot bolt (60) for holding vehicle wheels at a desired location. Hahn does not teach towing, but manually positioned wheel chocking apparatus, and Hahn's pin (60) is not a pivot bolt, but a pin for temporarily manually securing dolly (40) to track (12). Hahn's pin (60) is part of dolly (40), not part of a means for adjusting a movable vehicle locator swivel plate.

Hence, even *assuming arguendo* that there could be a basis for combining the Hahn and Young limitations with Chumley's swivel plate, such a proposed combination would still not realize applicant's invention as claimed without substantial modification. But it is known that in order to arrive at a claimed invention by modifying, the references cited art must themselves contain a suggestion for such modifications.

This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in In re Randol and Redford, (165 USPQ 586), that prior patents are references only for what they clearly disclose or suggest; it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest. To arrive at a claimed invention by modifying, the references cited art must themselves contain a suggestion for such modifications[1]. This well known principle is found in ATD Corp. The Lydale, Inc., 48 USPQ 2d 1321, 1329 (Fed. Cir. 1999):

> "Determination of obviousness can not be based on the hindsight combination of components selectively culled from the prior art to feed the parameters of the patented invention. There must be a teaching or suggestion within the prior art within general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources of the information, to select particular elements, and to combine them in the way they were combined by the inventor".

None of Chumley, Young or Hahn discloses any hint or suggestion for their combination, or any hint or suggestion that the elements they disclose could be modified.

---

[1] This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in re Randol and Redford (165 USPQ 586) that Prior patents are references only for what they clearly disclose or suggest; it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

Applicant respectfully asserts, therefore, that it would not have been obvious to modify Chumley by Young, and Young and Chumley by Hahn to realize the invention as claimed.

Applicant further respectfully asserts that the Examiner has not established a prima facie case of obviousness under obvious to try test for obviousness. The state and explanation of the application of "obvious to try" test for obviousness is explained in detail in In Re Marek Z. Kubin and Raymond G. Goodwin, 2008-1184 (Fed. Cir. April 3, 2009). An obviousness finding is appropriate where the prior art contained detailed enabling methodology for practicing the invention as claimed, a suggestion to modify the prior art to practice the invention as claimed, and evidence suggesting it would be successful. Id. at 15, citing In Re O'Farrell, 853 F.2d 894 (Fed. Cir. 1988).

It is clear that Chumley would need to be modified significantly to operate with Young's supporting cradle 70. Chumley's movable vehicle locator swivel plate or at least Chumley's adjusting means would have to be modified or replaced with Young's' longitudinally adjustable vehicle plate. The combination of Chumley and Young would then need modification to cooperate with Hahn's downwardly extending pivot bolt (60). But because there is no suggestion for modifying Chumley, modifying Young or modifying Hahn, there can be no expectation of success. That is, the fact that Chumley, Young and Hahn would have to be modified to be able to cooperate together renders it unlikely that the skilled artisan would think to combine them.

Applicant respectfully asserts that the Office Action fails to establish a prima facie case obviousness under the obvious to try test, that the invention is not innovation but was realizable by simple common sense of the person of ordinary skill in the art of the invention, and that said skilled artisan would have had a reasonable expectation that the combination would realize an invention as claimed.

Moreover, in response to the Examiner's comments at page 6 of the final Office Action, applicant respectfully asserts that the amended Affidavit under 37 CFR 1.132[2] is not required to demonstrate that the "instant invention" alone resulted in improved sales, but only that there is a nexus between the improved sales and the invention. MPEP 1504.03; Avia Group Int'l Inc. v. L.A. Gear, 7 USPQ2d 1548 (Fed. Cir. 1988), and that the 1.132 Affidavit clearly articulates the nexus between the sales of the tow device and the novel feature of the invention as claimed.

That is, applicant's 1.132 Affidavit closely ties his economic success to the inventive load adjustment facilitated by the MLSP and means for adjusting the MLSP as claimed. The 1.132 Affidavit sets forth and evidences that the inventive tandem tow device and method as claimed provide an adjustable car locator swivel plate that allows the adjustment of the weight distribution to "fine tune" the load, i.e., RV hitch

---

2 The Examiner states that applicant's declaration of commercial success is not convincing as it is not clearly demonstrated that the "instant invention" alone resulted in improved sales as [improved sales] may have been caused by other factors such as improved marketing and increasing sales for the overall market."

requirements, and that sales on the product as claimed began sales in the fourth quarter of the year 2003.

From that time, the tandem tow trailers, as claimed in the above-identified patent application, went from sales of $14,679 in 2003 to $222,231 in 2004, to $333,124 in 2005, to $371,682 in 2006, $511,456 in 2007, and $543,125 in 2008, with total cumulative sales of $1,996,297 since their introduction in 2003 (more than a hundred thirty fold increase). The Affidavit presents testimonial evidence that potential customers and customers articulate the desirability and commercial success of the tandem tow trailer device (customer feedback) in the tandem tow trailer's ability to adjust and balance the load using the movable vehicle locator swivel plate, which is clear evidence of the nexus between the invention, including the movable vehicle locator swivel plate.

Even though the evidence presented in the 1.132 affidavit cannot be said to be the "only" factors affecting commercial success, the evidence presented clearly shows some nexus between the invention as claimed, and commercial success, and the patentable weight of this evidence of commercial success should be considered in the obviousness determination. Hence, applicant respectfully requests that the Examiner consider the evidence of the commercial success of the invention as claimed, as set forth in the Affidavit under 37 CFR 1.132 in its reconsideration of the obviousness rejection based on Chumley combined/modified by Young/Hahn.

In view of the above presented remarks, and in view of the amended Affidavit under 37 CFR 1.132, it is believed to be clear that independent claims 54 and 61, the

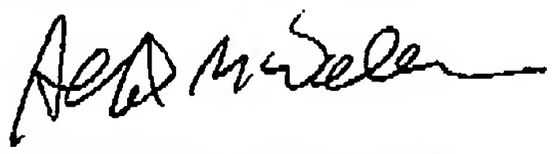
broadest apparatus and method claims, should be considered as patentably distinguishing over the art and should be allowed. As for the dependent claims 56 and 58-60, these claims depend on the corresponding independent claims, they share their allowable features, and they should be allowed as well.

The Examiner is requested to call the undersigned if further changes are required to obtain allowance of the application.

A favorable action is solicited.

August 10, 2009

Respectfully submitted,



ALFRED M. WALKER
Attorney for Applicant
Reg. No. 29, 983
225 Old Country Road
Melville, NY 11747-2712
631-361-8737

John Vodopia (36,299)
of counsel to Alfred Walker